

REMARKS/ARGUMENTS

STATUS OF THE APPLICATION

Claims 1-17 and 19-45 were pending in this application and examined.

Claims 1-6, 11-17, 21-27, and 37-45 were rejected under 35 U.S.C. § 101.

Claims 6, 8, 9, 10, 17, 19, 20, 36, and 39 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1-5, 9-17, 19-27, and 37-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over PR Newswire article "Caldor Announces Agreement with New York State Attorney General," dated January 11, 1993 ("Caldor") and further in view of WO 98/38589 to Abell ("Abell").

Claims 6-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Caldor and further in view of Abell and further in view of U.S. patent number 6,185,541 to Scroggie et al. ("Scroggie").

Claims 1-17, 19-27, and 36-47 are pending in this application. Claims 1, 6-10, 17, 19-20, 36, and 39 have been amended. Claims 46-47 has been added. Support for amended and new claims can be found in the specification. No new matter has been added.

Claims 28-35, previously withdrawn pursuant to a restriction rejection, have been canceled without prejudice. Applicant retains the right to present claims 28-35 in divisional applications.

THE CLAIMS

Reconsideration and allowance of the claims are respectfully requested in light of the amendments and following remarks.

35 U.S.C. § 101

Independent method claim 1 has been amended to specifically recite the words "computer implemented" to emphasize that the method is performed by a computer. Applicant accordingly submits that claim 1, as amended, complies with 35 U.S.C. § 101. Further, claims 2-6, 11-17, 21-27, and 37-45, which depend from claim 1, comply with 35 U.S.C. § 101.

35 U.S.C. § 112

Applicant respectfully submits that claims 6, 8, 9, 10, 17, 19, 20, 36, and 39 have been amended to distinctly claim the subject matter which Applicant regards as the invention.

35 U.S.C. § 103(a)

Claim 1-17, 19-27, and 37-45

Applicant submits that claim 1, as amended, is patentable over the cited references. Claim 1, as amended, recites:

"1. A computer implemented method of extending promotional discounts on items for sale to consumers, comprising:

...
prolonging the promoting beyond the predetermined time period upon determining that said consumer has acknowledged said promoting within the predetermined time period,

wherein the prolonging is independent of availability of the first selected item during the predetermined period." (Applicant's Claim 1, emphasis added)

As shown above, independent claim 1, as amended, specifically recites that the "... prolonging is independent of availability of the first selected item during the predetermined period." The prolonging step is not contingent upon the item being unable during the predetermined time period when the special price is promoted.

Applicant submits that Caldor does not teach or even suggest the concept of prolonging the promoting beyond the predetermined time period upon acknowledgement by the

consumer independent of availability of the item during the predetermined time period, as claimed in claim 1. In Caldor, a rain check (that enables a customer to purchase an advertised item at the sale price for a specified time beyond the sale period) is provided to the customer only when the customer attempts to purchase an advertised item during a sale period and the item is unavailable during the sale period. Caldor recites, "[w]here an advertised item is unavailable during a sale period, Caldor's policy entitles the customer ... to a rain check to purchase the advertised item at the sale price for a specified time beyond the sale period." (Caldor: page 1). Accordingly, in Caldor, both conditions of (1) customer must attempt to purchase within the sale period and (2) the advertised item must be unavailable during the sale period, have to be satisfied before the customer is entitled to the rain check.

Unlike Caldor, under Applicant's claim 1, neither of the conditions required by Caldor is required in order to prolong the predetermined time period. The consumer need not attempt to purchase the advertised item before the end of the predetermined time period to receive the discount or special price. The consumer can merely acknowledge the promotion thereby prolonging the promotion period and allowing the consumer to postpone his/her purchasing decision. Further, the prolonging is not contingent on the unavailability of the item during the predetermined time period. Whether or not the item is available is irrelevant to the prolonging of the time period when the special price is offered. This has been specifically recited in claim 1 as "wherein the prolonging is independent of availability of the first selected item during the predetermined period." Applicant thus respectfully submits that such a concept as recited in claim 1 is not taught nor even hinted at by Caldor.

Furthermore, claim 1 specifically recites that the method is "a computer implemented method." Caldor fails to teach a computer implemented method for extending promotional discounts. Nowhere does Caldor teach or suggest that any of the steps for extending the sale period are computer implemented. In fact, Examiner has also naturally assumed the "determining" to be done by a store clerk — not a computer. (See Office Action: page 9).

Further, Applicant submits that Abell also does not teach or suggest at least the concept of prolonging the promoting beyond the predetermined time period upon acknowledgement by the consumer independent of the availability of the item during the

predetermined period. Abell is cited merely for allegedly disclosing a method of extending promotional discounts to a targeted consumer wherein a selected item is promoted to a consumer identified by a unique identifier. However, Abell does not cure the deficiencies of Caldor. Applicant thus respectfully submits that even if Caldor and Abell were combined (and there is no clear motivation to do so), the resultant combination would not teach or even suggest the features of present invention as recited in claim 1.

Accordingly, Applicant submits that claim 1 should be allowable for at least these reasons.

Claims 1-17 and 19-27, 37-45, which depend from claim 1, should be allowable for at least a similar rationale as discussed above for claim 1, as well as the additional features they recite.

In addition, with respect to claims 6-8, Scroggie is cited merely for allegedly disclosing a method of distributing discounts via a computer network to identified consumers wherein the discounts are accessible from a kiosk at store locations, but Scroggie does not cure the deficiencies of Caldor and Abell.

New Claims 46-47

Claim 46 recites, in part, "... said identifying, promoting, withdrawing, determining and prolonging are performed by a computer network system." As discussed above, Caldor does teach or suggest this feature as claimed. For example, nowhere does Caldor teach or suggest that any steps as claimed be performed by a computer network system.

Accordingly, claim 46 should be allowable for at least these reasons.

Claim 47, which depends from claim 46, should be allowable for at least a similar rationale as discussed above for claim 46, as well as the additional features it recites.

Appl. No. 09/558,945
Amdt. dated May 10, 2004
Reply to Office Action of February 9, 2004

PATENT

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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